

Document: 1071452

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In the matter of a US patent application based on  
International Patent Application No. PCT/GB01/03174  
in the name of Chequepoint Franchise Corporation

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**Affidavit of John D. Collins**  
**For Submission to the United States Patent and Trade Mark Office**

I, John D. Collins, being duly sworn, hereby depose and state as follows:

1. I make this affidavit based on my personal knowledge.
2. I am a partner with the firm of Patent Attorneys Marks & Clerk of 90 Long Acre, London, WC2E 9RA, England.
3. I have principal responsibility within Marks & Clerk for all Chequepoint Franchise Corporation patent cases, including International Patent Application No. PCT/GB01/03174 and United States Provisional Patent Application No. 60/303263 in the name of Chequepoint Franchise Corporation.
4. I take instructions in respect of all Chequepoint Franchise Corporation patent cases from Mr Felix Grovit of Harada Limited. It is my understanding that Mr Grovit is fully authorised to give such instructions on behalf of the Chequepoint Franchise Corporation.
5. When a client instructs me to make a first filing for an invention in the United States, it is my normal custom – in general, and for Chequepoint Franchise Corporation specifically – to prepare and file a full (non-provisional) United States patent application, and to prosecute this application to grant independently of any International patent applications which may subsequently be filed.
6. On 5 July 2001 I instructed a firm of US attorneys (Schwegman, Lundberg, Woessner & Kluth, P.A.) to file United States Provisional Patent Application No. 60/303263. The application was (unusually) filed as a US provisional application because of an imminent disclosure of the invention which did not permit sufficient time for preparing a full and complete patent specification.
7. On 13 July 2001 I filed International Patent Application No. PCT/GB01/03174, claiming priority from United States Provisional Patent Application No. 60/303263. The International application was a more complete specification than the previous US provisional filing and, accordingly, it was my intention to enter it into the US national phase after the 30 month deadline, to replace the previous provisional application. Thus, I let United States Provisional Patent Application No. 60/303263 lapse by not taking the necessary steps to convert it into a full (non-provisional) US patent application.

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8. On 26 March 2003 I sent a letter (Exhibit 1) to Mr Grovit seeking his instructions regarding the national/regional phase of International Patent Application No. PCT/GB01/03174.

9. On 2 December 2003 I sent a second letter (Exhibit 2) to Mr Grovit reminding him that his instructions were still awaiting regarding the national/regional phase of International Patent Application No. PCT/GB01/03174. When preparing this letter, I noticed that a corresponding US patent application already existed in our records. I incorrectly assumed, in view of my normal practice regarding US first filings, that this was a full (non-provisional) pending US patent application, and I included a statement in my letter to this effect.

10. It has always been my understanding that Mr Grovit intended to obtain patent protection in the US based on International Patent Application No. PCT/GB01/03174, but because of the incorrect assumption which both Mr Grovit and I relied upon, I did not complete the formalities for entering International Patent Application No. PCT/GB01/03174 into the US national phase by the due date of 5 January 2004.

11. In accordance with the normal operation of the PCT system, the missed filing date of the United States patent application was not formally drawn to my attention, and I only recently became aware (in the week commencing 14 March 2005) of the error, during a portfolio review carried out in connection with work to correct inventorship details of all the members of the patent family to which International Patent Application No. PCT/GB01/03174 and United States Provisional Patent Application No. 60/303263 belong. On discovering the error which had occurred, I took immediately took steps to rectify the situation.

SIGNED AND SWORN TO UNDER THE PAINS AND PENALTIES OF PERJURY, THIS  
31ST DAY OF MARCH, 2005

  
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John D. Collins

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